In the Supreme Court of the United States.

OCTOBER TERM, 1898.

THE UNITED STATES EX REL. ALFRED L. Bernardin, plaintiff in error,
v.
CHARLES H. DUELL, COMMISSIONER OF Patents, defendant in error.
} No. 444.

BRIEF FOR THE DEFENDANT IN ERROR.

STATEMENT.

THE CASE.

The question arose in this way. In an interference proceeding in the Patent Office between Bernardin and Northall, the Commissioner decided in favor of Bernardin. Northall, under sections 4911 et seq., Revised Statutes, appealed to the court of appeals for the District of Columbia, which reversed the decision of the Commissioner, finding in favor of Northall. Bernardin then insisted

that the provisions for an appeal to the court are void and inoperative because repugnant to the Constitution, and instituted this proceeding in mandamus to compel the Commissioner to issue a patent to him.

It is to be noted that since the decision of the court of appeals of the District in the interference case, Bernardin has filed a bill in equity in the circuit court of the United States for the district of Indiana, under section 4915, Revised Statutes, to secure the patent, despite the reversal of the decision of the Commissioner based upon the action of the court of appeals. (Record, pp. 42–48).

THE QUESTION.

The question is, has Congress power to authorize the court of appeals of the District of Columbia to review the action of the Commissioner of Patents in an interference case?

The appellant contends that the Commissioner of Patents is an executive officer, and that his action in determining which of two claimants is entitled to a patent is an executive act, which can not be reviewed by a judicial tribunal.

The Government concedes that the Commissioner of Patents is an executive officer, but denies that his action in the case stated is of a purely administrative or executive character, insisting, on the contrary, that it is essentially of a judicial nature, involving the exercise of judgment and discretion upon questions of law and fact, in matters of right, which affect the individuals concerned, as well as the public, and may therefore be properly subjected, on appeal, to the review of a court.

THE STATUTES.

The following are the statutes involved in this case:

Sections 4911 to 4914, inclusive, provide for an appeal from the decision of the Commissioner, in patent cases, except where an interference is declared, to the supreme court of the District of Columbia.

Section 4915 provides the remedy by bill in equity where an application for patent is refused.

Section 780 is the general provision in the statutes relating to the District of Columbia, which gives the supreme court of the District, sitting in banc, jurisdiction of appeals from the Commissioner.

Section 9 of the act creating the court of appeals for the District vests in that court the jurisdiction on appeal from the decisions of the Commissioner formerly exercised by the supreme court of the District, sitting in banc, *and also provides for an appeal in interference cases.*

> SEC. 4911. If such party [an applicant for a patent or reissue, or a party to an interference, see section 4909], except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.
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> SEC. 4912. When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, *his reasons of appeal*, specifically set forth in writing.
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> SEC. 4913. The court shall, before hearing such appeal, *give notice to the Commissioner* of the time

and place of the hearing, and on receiving such notice *the Commissioner shall give notice of such time and place* in such manner as the court may prescribe, *to all parties who appear to be interested therein.* The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And *at the request of any party interested,* or of the court, *the Commissioner and the examiners may be examined under oath,* in explanation of the principles of the thing for which a patent is demanded.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint, and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, *and shall govern the further proceedings in the case.* But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent, on application is, refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge

that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor not.

SEC. 780 (Revised Statutes relating to District of Columbia, etc.). The supreme court, sitting in banc, shall have jurisdiction of, and shall hear and determine, all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes (Patents, Trade-marks, and Copyrights).

(27 Stat., p. 436, act creating court of appeals for the District of Columbia.)

SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents *in any interference case* may appeal therefrom to said court of appeals.

ARGUMENT.

I.

WHERE THE CONSTITUTIONALITY OF A LAW IS INVOLVED, EVERY POSSIBLE PRESUMPTION IS IN FAVOR OF ITS VALIDITY, AND THIS CONTINUES UNTIL THE CONTRARY IS SHOWN BEYOND A REASONABLE DOUBT.

"Every possible presumption," said Mr. Chief Justice Waite, speaking for the court in the *Sinking Fund Cases* (99 U. S., 700, 718), "is in favor of the validity of a statute, and this continues until the contrary is shown beyond a reasonable doubt. One branch of the Government can not encroach on the domain of another without danger. The strength of our institutions depends in no small degree on a strict observance of this salutary rule."

In *Powell* v. *Penna.* (127 U. S., 678, 684), the court, speaking by Mr. Justice Harlan, quotes this language with approval, and cites also *Fletcher* v. *Peck* (6 Cranch, 87, 128); *Dartmouth College* v. *Woodward* (4 Wheat., 518, 625); *Livingston* v. *Darlington* (101 U. S., 407).

II.

THE CONSTITUTION CONFERS UPON CONGRESS POWER TO PROVIDE FOR THE ISSUE OF PATENTS TO INVENTORS.

Section 8 of Article I of the Constitution, the same section which empowers Congress to regulate commerce with foreign nations and among the several States, provides expressly that Congress shall have power:

> To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

III.

CONGRESS MAY MAKE ALL LAWS WHICH SHALL BE NECESSARY AND PROPER FOR CARRYING INTO EXECUTION THE FOREGOING POWER.

Under the last clause of section 8 of Article I of the Constitution, Congress is given power "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers," etc. Thus Congress has power to do whatever is necessary, or seems to it necessary, to carry into effect an express power.

In the great case of *McCulloch* v. *Maryland* (4 Wheaton, 316, 421), Mr. Chief Justice Marshall laid down the rule, which has been followed ever since:

> The sound construction of the Constitution must allow to the national legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it in the manner most beneficial to the people. *Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional.*

IV.

THE SELECTION OF THE MEANS RESTS WITH CONGRESS. UNLESS THESE MEANS ARE FORBIDDEN BY THE CONSTITUTION, THE COURTS WILL NOT INTERFERE.

In the case of *McCulloch* v. *Maryland*, already cited, Mr. Chief Justice Marshall said (page 423):

> *Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Gov-*

ernment, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power.

This language was quoted with approval by Mr. Justice Gray, speaking for the court in the recent case of *Fong Yue Ting* v. *U. S.* (149 U. S., 698, 712), and also by Mr. Justice Harlan, who delivered the opinion of the court in the later case of the *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447, 472), with the following additional language (p. 473):

> It is a settled principle of constitutional law that "the Government which has a right to do an act, and has imposed upon it the duty of performing that act, must, according to the dictates of reason, be allowed to select the means; and those who contend that it may not select any appropriate means, that one particular mode of effecting the object is excepted, take upon themselves the burden of establishing that exception." (4 Wheat., 316, 409.) The test of the power of Congress is not the judgment of the court that particular means are not the best that could have been employed to effect the end contemplated by the legislative department. The judiciary can only inquire whether the means devised in the execution of a power granted are forbidden by the Constitution. It can not go beyond that inquiry without intrenching upon the domain of another department of the Government. That it may not do with safety to our institutions. (*Sinking Fund Cases*, 99 U. S., 700, 718.)

V.

HOW CONGRESS HAS EXERCISED ITS DISCRETION IN PROVIDING, AND CHANGING FROM TIME TO TIME, THE MEANS FOR ISSUING PATENTS.

In the case of *Butterworth* v. *Hoe* (112 U. S., 51), which will be discussed later, Mr. Justice Matthews, speaking for the court, gives the following account of patent legislation (page 64):

> The first statute on the subject of patents, act of 1790, ch. 7, 1 Stat., 109, authorized their issue by the Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, "if they shall deem the invention or discovery sufficiently useful and important."
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> The act of 1793, ch. 11, 1 Stat., 318, which next followed, authorized them to be issued by the Secretary of State, upon the certificate of the Attorney-General that they are conformable to the act. The ninth section of the statute provided for the case of interfering applications, which were to be submitted to the decision of arbitrators, chosen one by each of the parties and the third appointed by the Secretary of State, the decision or award of two of whom should be final as respects the granting of the patent.
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> This continued to be the law until the passage of the act of 1836, chapter 357, 5 Stat., 117, creating in the Department of State the Patent Office, "the chief officer of which shall be called," it says, "the Commissioner of Patents," and "whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries,

inventions, and improvements as are herein provided for or shall hereafter be by law directed to be done and performed," etc. By that act it was declared to be the duty of the Commissioner to issue a patent if he "shall deem it to be sufficiently useful and important," the very discretion previously vested in the three heads of departments by the act of 1790; and, in case of his refusal, the applicant was (sec. 7) secured an appeal from his decision to a board of examiners, to be composed of three disinterested persons, appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertained. The decision of this board being certified to the Commissioner, it was declared that "he shall be governed thereby in the further proceedings to be had on such application." A like proceeding, by way of appeal, was provided in cases of interferences. By section 16 of the act a remedy by bill of equity, as now given in sections 4915, 4918, Revised Statutes, was given as between interfering patents or whenever an application shall have been refused on an adverse decision of a board of examiners. By section 11 of the act of 1839, chapter 88, 5 Statutes, 354, as modified by the act of 1852, chapter 107, 10 Statutes, 75, it was provided that in all cases where an appeal was thus allowed by law from the decision of the Commissioner of Patents to a board of examiners the party, instead thereof, should have a right to appeal to the chief justice or to either of the assistant judges of the circuit court of the United States for the District of Columbia; and by section 10 the provisions of section 16 of the

act of 1836 were extended to all cases where patents are refused for any reason whatever, either by the Commissioner or by the chief justice of the District of Columbia upon appeals from the decision of the Commissioner, as well as where the same shall have been refused on account of or by reason of interference with a previously existing patent.

In this state of legislation the Patent Office, by the act of 1849, chapter 108, 9 Statutes, 395, was transferred to the Department of the Interior, the Secretary of which, it was enacted, "shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents now exercised by the Secretary of State;" which language, so far at least as appeals, strictly so-called, are concerned, was without force, as no appeals had ever been given from any decision of the Commissioner to the Secretary of State, unless that can be called so, which, by section 7 of the act of 1836, 5 Statutes, 120, was to be determined by a board of examiners, appointed, *pro re nata*, by the Secretary of State, and for which, as we have seen, an appeal to the chief justice of the circuit court of the District of Columbia had been substituted by the act of 1839, 5 Statutes, 354. The act of 1861, chapter 88, 12 Statutes, 246, created the office of examiners in chief, "for the purpose of securing greater uniformity of action in the grant and refusal of letters patent," "to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine, in like manner, upon the validity of the decisions of

examiners in interference cases, and, when required by the Commissioner, in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

The act of July 8, 1870, 16 Statutes, 198, revised, consolidated, and amended the statutes then in force on the subject, and the substance of its provisions, material to the present inquiry, have been carried into the existing revision.

It will be observed that the judgment and discretion vested, by the original patent law of 1790, in a majority of the three executive officers—the Secretary of State, the Secretary for the Department of War, and the Attorney-General—who were authorized to cause letters patent to issue "if they shall deem the invention or discovery sufficiently useful and important," was transferred by the act of 1836, section 7, to the Commissioner of Patents, it being made his duty to issue a patent for the invention "if he shall deem it sufficiently useful and important;" and is continued in him by Revised Statutes, section 4893, the language being that he shall cause an examination to be made of the alleged new invention "and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

VI.

IN DETERMINING WHETHER A PATENT SHALL ISSUE OR NOT, AND IF ISSUED TO WHOM, THE COMMISSIONER OF PATENTS ACTS NOT IN A PURELY EXECUTIVE OR ADMINISTRATIVE, BUT IN A QUASI-JUDICIAL CAPACITY.

After giving the history of the legislation on the subject of patents, quoted under the last point from *Butterworth* v. *Hoe*, Mr. Justice Matthews describes the character of the judgment and discretion which, under the statutes, is vested in the Commissioner (112 U. S., p. 66):

> It thus appears, not only that the discretion and judgment of the Commissioner, as the head of the Patent Office, is substituted for that of the head of the Department, but also, *that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which ample and elaborate provision is made; and that his discretion and judgment, exercised upon the material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute.* In no event could the direction of the Secretary of the Interior extend beyond the terms in which it is vested—that is, to the duties to be performed under the law by the Commissioner. The supervision of the Secretary can not change those duties nor require them to be performed by another, nor does it authorize him to substitute his discretion and judgment for that of the Commissioner, when, by law, the Commissioner is required to exercise his own, and when that judgment, unless reversed, in the special mode pointed out, by judicial process, is by law the condition on which the right of the claimant is declared to depend. *The conclusion can not*

be resisted that, to whatever else supervision and direction on the part of the head of the Department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of JUDICIAL ACTION *that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of* A JUDICIAL ACT. *That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.*

The essentially judicial character of the hearing before the Commissioner in a patent case is confirmed by the provisions which Congress has made for the securing by interested parties of the necessary testimony in patent cases through the compulsory process of the courts. The following are the statutes which Congress has passed authorizing the courts, upon the application of any party to a patent case, to issue its process commanding any desired witness to appear and testify before an officer authorized to take depositions, and to enforce the attendance by contempt proceedings if necessary:

SEC. 4906. The clerk of any court of the United States for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the appli-

cation of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

SEC. 4907. Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

SEC. 4908. Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

VII.

WHILE IT IS TRUE THAT THE COURTS CAN NOT BE SUBORDINATED TO THE EXECUTIVE OR USED IN A MERELY ADVISORY CAPACITY, THE WELL-CONSIDERED DECISIONS OF THIS COURT SUSTAIN THE AUTHORITY OF CONGRESS TO MAKE USE OF THE COURTS IN AID OF AN EXECUTIVE OFFICER OR BODY. THE ONLY RESTRICTION IS, THAT THE ACTION CALLED FOR BY THE COURT SHALL BE OF A JUDICIAL NATURE AND THAT ITS JUDGMENT SHALL BE ENFORCEABLE. CONGRESS MAY, THEREFORE, SUBJECT THE JUDICIAL ACTION OF THE COMMISSIONER IN A PATENT CASE TO THE REVIEW OF A COURT.

1. It is the nature of the action taken, and not the character of the officer who takes it, which determines whether Congress may submit it to the review of the courts. Action which is essentially judicial in its nature may properly be subjected to the revision of a court, no matter if taken originally by an administrative officer or board. It can not be denied that in deciding whether a patent shall issue or not the Commissioner must exercise judicial functions. He hears testimony, he finds the facts, he applies the law, he decides questions of right affecting not only public but private interests. In a case of issue, reissue, or extension the question is between the Government and the claimant; in an interference case, between two contesting claimants. The rights involved in a patent case and the nature of the action required of the Commissioner is well described by Mr. Justice Matthews, speaking for the court, in *Butterworth* v. *Hoe* (112 U. S., p. 58):

> The general object of that system is to execute the intention of that clause of the Constitution,

Article I, Section VIII, which confers upon Congress the power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved—that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law necessary to be applied in the settlement of this class of public and private rights have founded a special branch of technical jurisprudence. *The investigation of every claim presented involves the adjudication of disputed questions of fact upon scientific or legal principles, and is, therefore, essentially judicial in its character*, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions.

2. While the separation of the Government into three departments—legislative, executive, and judicial—may be conceded, and while the distinction between these departments should be preserved, yet it is not true, as apparently contended by the appellant, that every act of Government may be classified, so as to require its assignment without question to a particular department.

There are certain acts which can be classified and so assigned; there are others which can not be. Under the rule that Congress can not delegate its legislative power, there are certain acts which must be performed by the legislature. Under the rule that the judicial power must be vested in the courts, there are certain duties which must be entrusted to the courts. In accordance with the constitutional provision defining the limits of the Executive, there are acts which can only be performed by it. But there are certain acts which are on the boundary lines, which are difficult of classification, which may be done by Congress itself, or imposed upon the Executive or the judiciary.

Thus, in the States, the legislature may grant divorces or give the courts authority to grant them.

The legislature may change the names of citizens or refer such change to the courts.

The legislature may grant franchises or confer upon the Executive the authority to do so. Modifications or amendments of charters may be made by the legislature, or by the Executive, or the courts, as the legislature may see fit to provide.

Quasi judicial acts requiring the exercise of judgment and discretion may be entrusted to the Executive or to the courts, with an appeal to the courts.

Many illustrations in support of this proposition will suggest themselves to the court. It is only necessary for me now to refer to a few leading cases amply sustaining the authority of Congress to make use of the courts in aid of the Executive.

In *Murray* v. *Hoboken Land and Improvement Company* (18 Howard, 272) was involved the validity of a sale of land made by the United States marshal, under a distress warrant issued by the Solicitor of the Treasury, against a collector of customs, for a debt due the United States. It was contended that the power possessed by the marshal under the distress warrant was judicial power, which the Constitution required to be vested in the courts. The court held, after an examination of the history of similar proceedings in England and in this country, that the act provided due process of law. It was optional with Congress either to proceed for the collection of the amount due the United States from the collector by suit or by summary process of distress. The act did provide for a resort to the courts by the collector through his application to the district court. Such provision was consent by the United States to be sued in the particular matter. With respect to the option reposed in Congress under the Constitution, Mr. Justice Curtis, speaking for the court, said (p. 284):

> To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. *At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which*

Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

In the case of *Fong Yue Ting* v. *United States*, 149 U. S., 698), the constitutionality of the act of May 5, 1892, providing for the deportation of Chinese unlawfully within this country, came before this court. Among other provisions was one authorizing the officer who had arrested a person of Chinese descent, to bring him before a United States judge, who should summarily determine whether or not he should be deported. It was insisted that this provision was unconstitutional because it imposed upon the courts duties not judicial and made them subservient to the executive department, to which the act entrusted the carrying out of its provisions. This court, Mr. Justice Gray delivering the opinion, held the provision a valid one, taking the view that when the executive officer, acting in behalf of the United States, brings the Chinese laborer before the judge, in order that he may be heard, and the fact upon which depends his right to remain in the country be decided, a case is duly submitted to the judicial power. No formal complaint or pleadings are required.

The broad authority vested in Congress to select the means for executing the powers conferred is thus described (p. 712):

> As long ago said by Chief Justice Marshall, and since constantly maintained by this court: "The sound construction of the Constitution must allow to the National Legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution which will enable

> that body to perform the high duties assigned to it in the manner most beneficial to the people. Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional." "Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department and to tread on legislative ground. This court disclaims all pretensions to such a power." (*McCulloch* v. *Maryland*, 4 Wheat., 316, 421, 423; *Juilliard* v. *Greenman*, 110 U. S., 421, 440, 450; *Ex parte Yarbrough*, 110 U. S., 651, 658; *In re Rapier*, 143 U. S., 110, 134; *Logan* v. *United States*, 144 U. S., 263, 283.)

The following illustrations of the discretionary power vested in Congress to submit questions not necessarily of judicial cognizance either to the final determination of executive officers, or to their decision in the first instance, with an appeal to the courts, are given (p. 714):

> It is no new thing for the lawmaking power, acting either through treaties made by the President and Senate, or by the more common method of acts of Congress, to submit the decision of questions, not necessarily of judicial cognizance, either to the final determination of executive officers, or to the decision of such officers in the first instance, with such opportunity for judicial review of their action as Congress may see fit to authorize or permit.
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> For instance, the surrender, pursuant to treaty stipulations, of persons residing or found in this

country and charged with crime in another may be made by the executive authority of the President alone, when no provision has been made by treaty or by statute for an examination of the case by a judge or magistrate. Such was the case of Jonathan Robbins, under article 27 of the treaty with Great Britain of 1794, in which the President's power in this regard was demonstrated in the masterly and conclusive argument of John Marshall in the House of Representatives. (8 Stat., 129; Wharton's State Trials, 392; Bee, 286; 5 Wheat., appx. 3.) But provision may be made, as it has been by later acts of Congress, for a preliminary examination before a judge or commissioner; and in such case the sufficiency of the evidence on which he acts can not be reviewed by any other tribunal, except as permitted by statute. (Act of August 12, 1848, c. 167, 9 Stat., 302; Rev. Stat., secs. 5270–5274; *Ex parte Metzer*, 5 How., 176; *Benson* v. *McMahon*, 127 U. S., 457; *In re Oteiza*, 136 U. S., 330.)

So claims to recover back duties illegally exacted on imports may, if Congress so provides, be finally determined by the Secretary of the Treasury. (*Cary* v. *Curtis*, 3 How., 236; *Curtis* v. *Fiedler*, 2 Black, 461, 478, 479; *Arnson* v. *Murphy*, 109 U. S., 238, 240.) But Congress may, as it did for long periods, permit them to be tried by suit against the collector of customs. Or it may, as by the existing statutes, provide for their determination by a board of general appraisers, and allow the decisions of that board to be reviewed by the courts in such particulars only as may be prescribed by law. (Act of June 10, 1890., c. 407, secs. 14, 15, 25, 26 Stat., 137, 138, 141; *In re Fassett*, 142 U. S., 479, 486, 487; *Passavant* v. *United States*, 148 U. S., 214.)

To repeat the careful and weighty words uttered by Mr. Justice Curtis in delivering a unanimous

judgment of this court upon the question what is due process of law: "To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. *At the same time, there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.*" (*Murray* v. *Hoboken Co.*, 18 How., 272, 284.)

The following conclusive disposition is made of the contention that no case was submitted to the judicial power (p. 728):

> When, in the form prescribed by law, the executive officer, acting in behalf of the United States, brings the Chinese laborer before the judge, in order that he may be heard, and the facts upon which depends his right to remain in the country be decided, a case is duly submitted to the judicial power; for here are all the elements of a civil case—a complainant, a defendant, and a judge—*actor, reus et judex.* (3 Bl. Com., 25; *Osborn* v. *Bank of United States*, 9 Wheat., 738, 819.) No formal complaint or pleadings are required, and the want of them does not affect the authority of the judge, or the validity of the statute.

In *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447) it was contended that the twelfth sec-

tion of the Interstate-Commerce act, authorizing the circuit courts to use their process in aid of inquiries before the Commission, was in conflict with the Constitution, because it imposed on the courts duties not judicial in their nature. This court held otherwise. It took the view that a proceding under this section is not merely ancillary and advisory; that the judgment of the court is none the less that of a judicial tribunal dealing with judicial questions, because its effect may be to aid an administrative or executive body in the performance of duties imposed upon it by Congress. In the opinion, delivered by Mr. Justice Harlan, *Hayburn's case*, 2 Dall., 409; *United States* v. *Ferreira*, 13 Howard, 40; *Todd's case*, 13 Howard, 52; *Gordon* v. *United States*, 117 U. S., 697, and *In re* Sanborn, 148 U. S., 222, are examined and distinguished. These are the cases relied upon by the appellant.

The following extracts from the able and interesting opinion in this case show that the power of Congress to call the courts to the aid of the Executive, as provided in the interstate-commerce act, is sustained by the same line of reasoning, upon the same authorities, used in the Chinese deportation cases just cited:

As to the general power of Congress, page 472:

> The general principle applicable to this subject was long ago announced by this court, and has been so often affirmed and applied that argument in support of it is unnecessary, even if it were possible to suggest any thought not heretofore expressed in the adjudged cases. In the great case of *McCulloch* v. *Maryland* (4 Wheat., 316, 421, 423), it was said: "The sound construction of the Constitution must

allow to the National Legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it, in the manner most beneficial to the people. Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional." Again: "Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power."

As to what is a case which may be submitted, page 475:

What is a case or controversy to which, under the Constitution, the judicial power of the United States extends? Referring to the clause of that instrument, which extends the judicial power of the United States to all cases in law and equity arising under the Constitution, the laws of the United States, and treaties made or that shall be made under their authority, this court, speaking by Chief Justice Marshall, has said: "This clause enables the judicial department to receive jurisdiction to the full extent of the Constitution, laws, and treaties of the United States when any question respecting them shall assume such a form that the judicial power is capable of acting on it. That power is capable of acting only when the subject is submitted to it by a party who asserts his rights in the form prescribed by law. It then becomes a case, and the Constitution declares that the judicial power shall

extend to all cases arising under the Constitution, laws, and treaties of the United States." (*Osborn* v. *Bank of the United States*, 9 Wheat., 738, 819.) And in *Murray* v. *Hoboken Co.* (18 How., 272, 284) Mr. Justice Curtis, after observing that Congress can not withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty, nor, on the other hand, bring under judicial power a matter which, from its nature, is not a subject for judicial determination, said: "At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

The particular case described, page 477:

The United States asserts its right, under the Constitution and laws, to have these appellees answer the questions propounded to them by the Commission, and to produce specified books, papers, etc., in their possession or under their control. It insists that the evidence called for is material in the matter under investigation; that the subject of investigation is within legislative cognizance, and may be inquired of by any tribunal constituted by Congress for that purpose. The appellees deny that any such rights exist in the General Government, or that they are under a legal duty, even if such evidence be important or vital in the enforcement of the interstate-commerce act, to do what is required of them by the Commission. Thus has arisen a dispute involving rights or claims asserted by the respective parties to it. And the power to

> determine it directly, and, as between the parties, finally, must reside somewhere. It can not be that the General Government, with all the power conferred upon it by the people of the United States, is helpless in such an emergency, and is unable to provide some method, judicial in form, and *direct in its operation*, for the prompt and conclusive determination of this dispute.

The proceeding not merely advisory. Page 487.

> The present proceeding is not merely ancillary and advisory. It is not, as in *Gordon's Case*, one in which the United States seeks from the circuit court of the United States an opinion that "would remain a dead letter, and without any operation upon the rights of the parties." The proceeding is one for determining rights arising out of specified matters in dispute that concern both the general public and the individual defendants. It is one in which a judgment may be rendered that will be conclusive upon the parties until reversed by this court. And that judgment may be enforced by the process of the circuit court.

None the less a judgment because in aid of the executive. Bottom page 487.

> It is none the less the judgment of a judicial tribunal dealing with questions judicial in their nature, and presented in the customary forms of judicial proceedings, because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution.

In *United States* v. *Coe* (155 U. S., 76) the court sustained the constitutionality of the provision in the act establishing the Court of Private Land Claims, which authorizes an appeal to the Supreme Court of the United

extend to all cases arising under the Constitution, laws, and treaties of the United States." (*Osborn* v. *Bank of the United States*, 9 Wheat., 738, 819.) And in *Murray* v. *Hoboken Co.* (18 How., 272, 284) Mr. Justice Curtis, after observing that Congress can not withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty, nor, on the other hand, bring under judicial power a matter which, from its nature, is not a subject for judicial determination, said: "At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

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States. Reference is made, in the opinion by the Chief Justice, to the cases of *American Insurance Co.* v. *Canter* (1 Peters, 511, 546), and *McAllister* v. *United States* (141 U. S., 174), in which it was held that section 1 of article 3 does not exhaust the power of Congress to establish courts, but that Territorial courts and special tribunals may be created by virtue of control over Territories, and the general right of sovereignty which exists in the Government, and from these appeals may be provided to the Supreme Court of the United States.

Page 86:

> As wherever the United States exercise the power of government, whether under specific grant, or through the dominion and sovereignty of plenary authority as over the Territories (*Shively* v. *Bowlby*, 152 U. S. 1, 48), that power includes the ultimate executive, legislative, and judicial power, it follows that the judicial action of all inferior courts established by Congress may, in accordance with the Constitution, be subject to the appellate jurisdiction of the supreme judicial tribunal of the Government. There has never been any question in regard to this as applied to territorial courts, and no reason can be perceived for applying a different rule to the adjudications of the Court of Private Land Claims over property in the Territories.

In the recent case of *United States* v. *Lies* (170 U. S., 628), the court held that where the Government takes no appeal from the action of the board of general appraisers upon an importer's protest, made under the customs administrative act of June 10, 1890, it is bound by that action; and in case the importer appeals from that action, and subsequently abandons his appeal, the Government can

not claim to be heard, but it is the duty of the court to affirm the decision of the appraisers.

In that case the Government insisted that the application to the circuit court for a review of the questions of law and fact involved in the decision of the board of appraisers was the institution of an original proceeding and not an appeal or a proceeding in error to review a judicial determination made by the board of appraisers. It was urged that the proceeding before the board of appraisers is not a judicial one between private parties respecting property or personal rights, but a matter between the Government acting through its agents and the citizen. In order to afford the citizen every opportunity of being dealt with justly and lawfully, the application for review to the circuit court is provided. The California land-title cases, which are cited in the brief of the appellant, were relied upon in support of this contention. Notwithstanding the fact that it was conceded that the board of appraisers is not a court, but only an administrative body clothed with quasi judicial functions in the determination of questions of fact and law arising between the Government and the citizen in the collection of the revenue, the court held that the application for review to the circuit court is virtually and substantially an appeal to the circuit court from the decision of the board of general appraisers, and that if the Government desired to secure a review by the circuit court, it must file its request for an appeal. The opinion was delivered by Mr. Justice Peckham, who says (p. 636):

> Although the circuit court has, upon the application of the parties, power to take further testimony

after the case is brought before it, and to that extent it may be regarded as something in the nature of a new proceeding, yet the proper procedure in deciding the appeal is in nowise altered thereby, and unless a party has appealed, and filed and served his statement as above mentioned, the court ought not to reverse on his motion.

It is immaterial that the application is not named an appeal. It is such in substance, and the grounds and reasons for the appeal are to be stated. Although the board of general appraisers may not be a court, yet the proceedings to review its determination are pointed out by the statute, and they must be substantially followed and obeyed.

VIII.

THE CASE OF BUTTERWORTH V. HOE (112 U. S., 55) IS DECISIVE IN FAVOR OF THE APPELLEE HEREIN.

I submit that the case of *Butterworth* v. *Hoe*, from which quotations have been made, is decisive of this controversy and conclusive in favor of the validity of the existing law, permitting an appeal to the courts from the decision of the Commissioner of Patents.

Butterworth v. *Hoe* was a suit in mandamus, brought by a claimant of a patent in whose favor the Commissioner had found in an interference case, to compel the Commissioner to issue the patent to him. The Commissioner had refused to do this, on the ground that the defeated party in the interference case before him had appealed to the Secretary of the Interior, who had reversed the Commissioner's action and found in the appellant's favor.

The question, then, was between the action of the Secretary of the Interior, the head of an executive department, and that of his subordinate, the Commissioner of Patents.

In favor of the action of the Secretary, the same argument was made that is made here, namely, that the Commissioner of Patents is simply an executive officer, that his acts are purely executive in nature, and are therefore subject to review and revision by the head of the department of which he is a subordinate.

On the other hand, it was contended that while the Commissioner of Patents is an executive officer and subject in matters administrative or executive to the supervision of the head of the Department, yet, in deciding patent cases (and the case before him was an interference case), his action is essentially judicial in nature and therefore not subject to review by the executive head. In support of this the fact that an appeal is provided to the courts by Congress was relied upon.

This court held in favor of the latter view. It denied authority to the Secretary to review, because the action of the Commissioner is not executive, but judicial, and Congress has properly provided for an appeal to the courts.

The grounds for the contention that the Secretary had the authority to review are stated in the opinion of the court (112 U. S., 55). Among others is this:

> That this general relation of official subordination [of the Commissioner to the Secretary, which has been described], with the accompanying powers of supervision and direction, extends to all the official

> acts of the Commissioner, without regard to any distinction between those which are merely ministerial and those which are judicial in their nature.

The following quotations from the able opinion, delivered by Mr. Justice Matthews, show clearly that the decision was based upon the judicial nature of the action of the Commissioner in determining patent cases. While in executive matters the Secretary, as the head of the Department, has supervisory authority, yet in quasi judicial matters Congress has sufficiently shown that it intended the action of the Commissioner, in the exercise of his judgment and discretion, either to be final or to be reviewable only by the courts. The appeal provided to the courts conclusively showed the essential judicial nature of his action in patent cases.

Page 60:

> It is evident that the appeal thus given to the supreme court of the District of Columbia from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one in the statutory proceeding under the patent laws *whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication,* though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, *is, nevertheless, conclusive upon the Patent Office itself,* for, as the statute declares (Rev. Stat., sec. 4914), it "shall govern the further proceedings in the case." The Commissioner can not question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable

judicial process. *The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it;* it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole Department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the Secretary by acting directly upon the Commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdiction in appeals from the Commissioner to a judicial body, independent of the Department, as though he were the highest authority on the subject within it. And to say that under the name of direction and superintendence, the Secretary may annul the decision of the supreme court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to coexist without conflict.

Page 63:

Thus every case is fully provided for, both when the Commissioner wrongfully refuses to issue a patent, and when, in cases of interference, he erroneously issues one; and that by means of judicial proceedings through tribunals distinct from and independent of the Patent Office, the integrity and force of whose judgments would be annulled if not

regarded as conclusive upon the Commissioner, notwithstanding any power of direction and superintendence on the part of the Secretary, which is therefore necessarily excluded.

Bottom, page 63.

* * * No reason can be assigned for allowing an appeal from the Commissioner to the Secretary *in cases in which he is by law required to exercise his judgment on disputed questions of law and fact*, and in which no appeal is allowed to the courts that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all or does not extend to any. The true conclusion, therefore, is, that matters of this description, *in which the action of the Commissioner is quasi-judicial*, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied.

IX.

THE CONTROVERSY SUBMITTED TO THE COURT ON APPEAL FROM THE DECISION OF THE COMMISSIONER WAS A CASE WHICH MIGHT PROPERLY BE SUBMITTED TO A JUDICIAL TRIBUNAL.

The appellant discusses at some length in his brief the question whether there was "a case" which could be properly submitted to the judiciary. That there was a case is so apparent as hardly to require discussion. In *Fong Yue Ting* (149 U. S., 698, 728) Mr. Justice Gray, speaking for the court, pointed out that when the question was submitted to the court whether or not a Chinese laborer had a right to remain in the country, although no

formal complaint or pleadings were required, all the elements of *a case* existed. On one side the Chinese laborer, on the other the Government—a question of right to be decided, and a judge to determine it.

So in *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447), this court, speaking by Mr. Justice Harlan, pointed out the elements of a case which are present when the Interstate Commerce Commission, under the statute, applies to a court for its aid in compelling an answer to questions propounded by the Commission. On the one side is the Interstate Commerce Commission, on the other the refractory witness. A dispute exists as to the right of the Commission to the information demanded. The determination of this controversy may properly be submitted to the court.

In the present case, wherein an interference was declared, the parties before the court were citizens, adverse private claimants. The question was the right to a patent, more or less valuable, often of great value. The fact that such a controversy may be brought before a court by an original proceeding, in the nature of a bill in equity, is convincing upon the point that there is in it all the elements of a case for judicial determination. Whether such a case should be summarily submitted to the court by direct appeal from the decision of the Commissioner of Patents was for Congress to say.

CONCLUSION.

This case would be an important one if the statute providing for an appeal to the court of the District had

just been passed and no action taken under it. The question involved becomes an exceedingly grave one when it is considered that the jurisdiction to review the decision of the Commissioner in patent cases has been constantly exercised by the courts of the District since the year 1839, and (as stated by Justice Shepard, in his opinion in this case in the court of appeals, bottom page 2, printed copy filed herein) "of late years especially many decisions of the court, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final."

The extent of the confusion which would result from a decision of this court declaring the statute under consideration unconstitutional, and, therefore, all action of the courts under it null and void, may be faintly imagined. In this connection, may it not fairly be suggested that if no appeal lies to the courts, because the act of the Commissioner is not judicial but executive, then an appeal does and will lie to the Secreatry of the Interior, for the same reason, because the act is executive and not judicial; and, the action of the Commissioner not being final, the appellant is not entitled to the writ in this case.

The judgment of the lower court should be affirmed.

JOHN K. RICHARDS,
Solicitor-General.

NOVEMBER 29, 1898.

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In the Supreme Court of the United States.

OCTOBER TERM, 1898.

THE UNITED STATES EX REL. ALFRED L. Bernardin, plaintiff in error,
v.
CHARLES H. DUELL, COMMISSIONER OF Patents, defendant in error.
No. 444.

ADDITIONAL POINTS BY THE SOLICITOR-GENERAL ON ORAL ARGUMENT.

I.

With the wisdom of the appeal provided by Congress from the action of the Commissioner to the courts of the District, this court of course has nothing to do; but it was insisted in argument that such appeal was in no sense adapted to execute the power conferred on Congress to promote the progress of the useful arts by securing to inventors the exclusive rights to their respective discoveries, and much solicitude was expressed for the poor inventors who are thus compelled to resort to an additional tribunal.

I think the policy of providing this appeal can readily be sustained. The appeal provides for a review in a summary manner of the action of the Commissioner by a court. Difficult questions of law and fact are involved in patent cases. The statute does not require the Commissioner of Patents to be a lawyer. The tenure of a Commissioner is uncertain and at the best short. He changes with changing Administrations. The court of appeals, on the contrary, is composed of judges who hold during good behavior. Its members outlast Administrations. They are likely, in exercising this jurisdiction, to become familiar with patent law, and the questions which arise in issuing patents, and are apt to and do serve as a wise check upon the action of the Commissioners. The proceeding was made summary, so as to make it inexpensive, open to all applicants, however poor, and so as to present to the court the same questions upon the same facts which were before the Commissioner. An original investigation by the court upon new evidence would be slow and expensive, burdensome to the court, and costly to litigants. The appeal provided by statute secures the advantage of the learning and experience of the court upon the precise matters presented to the Commissioner.

II.

The decision of the court of appeals on an appeal from the Commissioner is not a dead letter, because the statute expressly provides that it shall be entered of record in the Patent Office, "*and shall govern the further proceedings in the case.*" Its binding quality is clearly described by Mr. Justice Matthews (112 U. S., 60).

The only exception made in the statute is that it shall not preclude any person interested from "the right to contest the validity of such patent." The appeal to the circuit court is one step in the proceedings terminating in the issue of the patent. Of course the validity of a patent thus issued may be subsequently contested in any court of competent jurisdiction.

III.

Section 4915, providing that whenever a patent is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have a remedy by bill in equity, does not provide for a means of contesting "the validity of the patent" (*Durban* v. *Seymour*, 161 U. S., 235, bottom 237), nor for a rehearing, upon equal terms, of the questions adjudicated in the Patent Office, as aided by the court of appeals.

The character of the proceeding under section 4915 is described in *Morgan* v. *Daniels* (153 U. S., 120, 124):

> But this is something more than a mere appeal. It is an application to the court to set aside the action of one of the executive departments of the Government. The one charged with the administration of the patent system had finished its investigations and made its determination with respect to the question of priority of invention. That determination gave to the defendant the exclusive rights of a patentee. A new proceeding is instituted in the courts—a proceeding to set aside the conclusions reached by the administrative department, and to give to the plaintiff the rights there awarded

to the defendant. It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence.

Page 125, top:

Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and quantity carries thorough conviction.

IV.

Mr. Dowell stated to the court that no patent had been issued, the inference being that the Patent Office had not issued the patent in accordance with the direction of the court of appeals because of the filing of the bill in equity under section 4915. It is true no patent has been issued, but this is because of the fact that the constitutional question now submitted to this court was then raised, and so the Commissioners held up the patent awaiting the settlement of this constitutional question. In ordinary cases, I am informed by the Patent Office, it is the rule, when the decision of the court of appeals requires the issue of a patent, for the Commissioner to issue it at once in accordance with the directions contained in the court's decision. Thus immediate effect is given to the decision of the court of appeals. It is treated as governing the further proceedings in the case in the Patent Office, and a patent is issued accordingly.

A reference to the case of *Morgan* v. *Daniels* (153 U. S., 120), just cited, shows that this is true. That was an interference case, in which the patent was issued according to the decision of the Commissioner, whereupon the defeated party resorted to the remedy under section 4915.

V.

If any section is open to the objection that it does not provide sufficiently for carrying into effect the decision of the court, it is section 4915, which simply provides that "such adjudication, if it be in favor of the right of the applicant, shall *authorize* the Commissioner to issue such patent on the applicant's filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law*."

My information from the Patent Office is that an adjudication under section 4915 is not recognized as being a final and conclusive determination that a patent shall and must issue to the successful applicant before the court. After a copy of the adjudication is filed in the Patent Office, there still remains in the Commissioner the discretion to pass upon the question whether the applicant has otherwise complied with the requirements of law.

VI.

A judgment of a court is not to be deemed a dead letter because it can be attacked in a judicial proceeding. A patent is at least *prima facie* proof that the patentee is entitled to the benefit of the invention. It is not, however, absolutely final and conclusive upon that point. It

may be questioned and attacked in various ways. A defeated applicant may attack it by bill in equity under section 4915. A party claiming an infringement may attack it by a suit which contests its validity. The Government may attack it by a suit to cancel the patent. In all these ways the action of the court of appeals and the action of the Commissioner of Patents carrying the decision of the court of appeals into effect may be attacked and possibly overthrown.

VII.

The appeal is a special statutory proceeding in aid of the Patent Office. The binding and important nature of the decision of the court of appeals is recognized by the appellant herein. Otherwise, why should he be so solicitous to have that decision declared null and void? If he could relitigate, under section 4915, upon equal terms with Northall the question of priority of invention, how explain his present action? He knows well enough that, in accordance with the decision of the court of appeals, the Commissioner will issue a patent to Northall, and that it will require him to satisfy a court by testimony, which, in character and amount, carries thorough conviction that the court of appeals and the Commissioner were wrong before he can overthrow their action.

J. K. RICHARDS,
Solicitor-General.

DECEMBER 3, 1898.

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No. 444.

Brief of Wilson

Office Supreme Court U. S.
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Clerk

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Supreme Court of the United States.

OCTOBER TERM, 1898.

No. 444

THE UNITED STATES *EX REL.* ALFRED L. BERNARDIN, PLAINTIFF IN ERROR,

vs.

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

WRIT OF ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR ASSIGNEE OF WILLIAM H. NORTHALL.

—BY—

JEREMIAH M. WILSON.

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IN THE

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WRIT OF ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF IN RESISTANCE OF APPLICATION FOR A WRIT OF MANDAMUS.

The question that is presented in the brief of counsel for plaintiff in error, and which it may be conceded is embraced in the record, is as follows:

Is it within the power of Congress to confer upon the Court of Appeals of the District of Columbia authority to review the action of the Commissioner of Patents in a case

where an interference has been declared?—the contention of the appellant being that the determination of such a case by the Commissioner of Patents is an administrative act, from which no appeal can lie to said court.

Or, to state this differently, the contention of the appellant is, that it is not within the power of Congress to confer upon the Court of Appeals the power to review the action of the Commissioner of Patents, in respect of determining which of two parties contending for a patent, and between whom, or between whose applications or assertion of priority, an interference has been declared, is entitled thereto.

In support of this contention counsel for appellant have cited numerous authorities to establish the propositions:

1. That this Government is divided into three co-ordinate branches—the legislative, executive, and judicial.

2. They cite numerous authorities to establish the proposition that no one of these branches can trespass upon the domain of either of the others as severally defined by the Constitution of the United States.

As to these propositions there is no dispute.

Congress Has the Power under Section 8 of the Constitution to Confer this Authority upon the Court of Appeals.

Counsel for plaintiff in error have, perhaps, inadvertently, overlooked the fact that section 8 of the Constitution provides that "Congress shall have power to "promote the progress of science and useful arts by secur- "ing for limited times to authors and inventors the exclu- "sive right to their respective writings and discoveries." No allusion is made to this provision of the Constitution in brief for plaintiff in error.

The real question in this case is whether Congress, under the provisions of the Constitution above quoted, has the power to use said court as an instrumentality or aid in the matter of securing to inventors the exclusive right to their discoveries, in respect of the securing of which express power is conferred upon Congress by the above-quoted provision of the Constitution. To this question the attention of the court is now invited.

I.

Congress Has the Implied Power to Enact Laws and Prescribe Means for the Carrying Out of Express Powers Conferred by the Constitution, and the Courts Cannot Nullify these Laws unless the Means so Provided are Forbidden by the Constitution Itself.

1. It is, perhaps, unnecessary to mention at this late day that it is beyond controversy that Congress has the *implied* power to do whatever is necessary, or deemed by it to be necessary, to carry into effect an *express* power. In the case of *McCulloch vs. The State of Maryland* (4 Wheat., 316–421), Chief Justice Marshall, in an exhaustive and elaborate discussion of this subject, states the conclusion of the court as follows:

"We think the sound construction of the Constitution must allow to the national legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it in the manner most beneficial to the people. *Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are*

not prohibited, but consist with the letter and spirit of the Constitution, are constitutional."

See, also—

Prigg vs. State of Pennsylvania, 16 Pet., 539.
Ex parte Yarbrough, 110 U. S., 651.
Gibbons vs. Ogden, 9 Wheat., 1 *et seq.*

In the light of the authorities and in the light of reason it is with great confidence asserted that it is left entirely to Congress to designate or appoint the means or instrumentalities to which it will resort to carry into effect this express power, so granted by the Constitution, to secure to inventors the benefits of their discoveries.

See *Interstate Commerce Com. vs. Brimson, infra.*

2. It is also respectfully submitted that it is not within the power of any court to criticise these means or instrumentalities or to determine that they are in anywise injurious for trenching upon the power of that other co-ordinate branch of the Government, the judiciary. Congress has just as much power to invoke the aid of the judge of any court or any judicial tribunal in the exercise of this expressly conferred power as it has to invoke the aid of any administrative or other officer or department of the Government.

In this connection, this court, in *McCulloch vs. State of Maryland* (4 Wheaton, 423), uses the following language:

"Should Congress, in the execution of its powers, adopt measures which are prohibited by the Constitution * * * it would be the painful duty of this tribunal, should a case requiring such a decision come before it, to say that such an act was not the law of the land. *But where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power.*"

This case is cited and the above extract is quoted with approval by the Supreme Court in the recent case of *Interstate Commerce Commission vs. Brimson* (154 U. S., 472).

3. It can scarcely be doubted that in respect of securing to inventors the exclusive right to their discoveries, Congress could have used the Treasury Department, or the State Department, or the Department of Justice, as well as the Interior Department, or that it could have created a special tribunal for that purpose, as in the cases of the Interstate Commerce Commission and the Court of Claims, which are merely ancillary or advisory tribunals (except where the power to render final judgment is expressly conferred upon the latter by Congress), or that it could determine controversies arising from interferences by its own action through its own committees; and it by no means follows that, having designated any one of these instrumentalities, it is limited to the use of that particular one. It may use any one of these, or it may use any one in connection with any other. It may, in any way that it conceives to be best calculated to carry into effect such express powers, prescribe any means that in its judgment may be most efficient in the performance thereof.

In the said case of *Interstate Commerce Commission vs. Brimson* (*supra*), at page 473, Mr. Justice Harlan says:

"Congress is not limited in its employment of means to those that are absolutely essential to the accomplishment of objects within the scope of the powers granted to it. It is a settled principle of constitutional law that '*the government which has a right to do an act, and has imposed upon it the duty of performing that act, must, according to the dictates of reason, be allowed to select the means, and those who contend that it may not select any appropriate means, that one particular mode of effecting the object is excepted, take upon themselves the burden of establishing that exception*' (4 Wheat., 409). The test of the power of Congress is not the judgment of the courts that particular means are not the best that could have been

employed to effect the end contemplated by the legislative department. *The judiciary can only inquire whether the means devised in the execution of a power granted are forbidden by the Constitution. It cannot go beyond that inquiry* without entrenching upon the domain of another department of the Government. That it may not do with safety to our institutions (*Sinking Fund cases*, 99 U. S., 709–718)."

II.

Congress Can Confer upon the Courts Jurisdiction to Hear and Determine Controversies Relating to the Issuing of Patents in Aid of the Exercise of the Power Conferred upon that Body by the Constitution.

The whole argument of counsel for plaintiff in error in this case rests upon the idea or proposition that as Congress has created a bureau in the Department of the Interior for the determination of questions of this character, it is, by this action, limited to what that bureau may do, and is precluded from going beyond that bureau and invoking the aid of some other instrumentality for the purpose of determining such controversies.

This contention, it is respectfully submitted, is novel, not only in that it is in contravention of what would seem to be elementary law, but because it is in conflict with the established practice of the Government almost from its beginning. In this connection the court is referred to the case of *Butterworth vs. Hoe* (112 U. S., 51), for the purpose of directing attention to the history of the legislation of Congress in respect of the methods provided by it for determining questions of this character.

This legislative history will be found commencing at page 64 of said volume of the United States reports, and from it

it will appear that, in the discharge of said duty to secure to inventors the exclusive benefit of their discoveries, in the year 1790 Congress passed an act (*1 Stats., 109*) authorizing the Secretaries of State and War and the Attorney General, or any two of them, to issue letters patent upon inventions if they should deem the same sufficiently useful or important.

In 1793 (*1 Stats., 318*) such patents were authorized to be issued by the Secretary of State, upon the certificate of the Attorney General, and by this act interfering applications were submitted to arbitrators, etc. By the act of 1836, creating in the Department of State a Patent Office, a Commissioner of Patents was provided for, who, under the direction of the Secretary of State, was to superintend, execute, and perform all such acts and things, touching and respecting the granting and issuing of patents, as are therein provided for, or may be hereafter by law directed to be done. If an applicant was not satisfied with the action of this Commissioner, he had a right to appeal to a board of examiners, to be composed of three disinterested persons, etc.

By section 16 of said act (now secs. 4915 and 4918 of the Revised Statutes), a remedy by bill in equity was provided. In 1839 (*5 Stats., 11*), as modified by the act of 1852 (*10 Stats., 75*), it was provided that in all cases where an appeal thus allowed by law from the decision of the Commissioner of Patents to a board of examiners, the party instead thereof should have a right of appeal to the chief justice or either of the associate justices of the circuit court of the United States for the District of Columbia. By the act of 1849 (*9 Stats., 395*), the Patent Office was transferred to the Department of the Interior.

For the further history of the legislation of Congress in regard to this matter, reference is made to said case of *Butterworth vs. Hoe.* But from what has already been mentioned, and from what will further appear by an examination of said case in respect of the history of such legislation,

it will be seen that from 1790 down to this time Congress has asserted and exercised its right to select, and has selected, the instrumentalities which it desired should be used for the purpose of carrying out the express provision of the Constitution above quoted, and that, since the year 1870, without question, Congress has asserted the power to use the courts of the District of Columbia as an instrumentality or aid in the exercise of such power.

In view of the above authorities, and of the hitherto unquestioned procedure of Congress, argument or illustration in support of the above-stated proposition would seem to be unnecessary. When it is said that "Congress shall have the power to secure," etc., such grant of power necessarily carries with it the power to declare or designate the means or the instrumentalities by which it will secure the objects to be attained.

As one of these instrumentalities Congress has created the office of Commissioner of Patents. He is a *quasi*-judicial officer, created for the purpose of determining which of two parties shall have issued to him a patent, or whether, in the absence of conflict, a patent shall be issued at all. As an incident of this duty, he must receive and consider the evidence submitted to him by the parties and the law applicable to the question in controversy. And now it is gravely asserted by counsel for plaintiff in error that Congress, whose right and duty it is to secure to inventors the benefits of their inventions, cannot go beyond the opinion of this Commissioner of Patents, but must be bound by his judgment alone. In other words, it is asserted that Congress may create a Commissioner of Patents, and may submit such matters to his judgment, but cannot subject his decision or judgment to review by any other tribunal.

It would seem that the mere statement of such a proposition carries with it the answer, to wit, that Congress, having the power to secure these rights, may adopt such methods

of securing them as in its discretion it may consider appropriate.

In the case of *Butterworth vs. Hoe, supra*, the court, in its opinion by Matthews, J., uses the following language, which would seem to be conclusive of the present question:

"It is evident that the appeal thus given to the supreme court of the District of Columbia from the decision of the Commissioner is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. *Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the Patent Office itself*, for, as the statute declares (Rev. Stats., sec. 4914) it 'shall govern the further proceedings in the case.' *The Commissioner cannot question it.* He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. *The decree of the court is the final adjudication upon the question of right;* everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the Secretary by acting directly upon the Commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

"Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included; giving jurisdiction, in appeals from the Commissioner, to a judicial body, independent of the department, as though he were the highest authority on the subject within it. And to say that, under the name of direction and superintendence, the Secretary may annul the decision of the supreme court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute

so as to make one part repeal another, when it is evident both are intended to coexist without conflict.

"The inference is that an appeal is allowed from the decision of the Commissioner refusing a patent, not for the purpose of withdrawing that decision from the review of the Secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the Commissioner should stand as the final judgment of the Patent Office, and of the executive department of which it is a part."

This is a clear and explicit statement of our position in respect of the question now before the court, namely, that what comes within the ordinary jurisdiction of the court is entirely foreign to the matter under discussion, the question being not whether a matter concerning the issuing of a patent is of judicial cognizance in the usual statutory or constitutional sense thereof, but whether Congress may use a judge or a court for the purpose of determining a question of this character.

Congress has not only provided for using the courts for this purpose, but by this opinion of the Supreme Court the right of Congress to use such instrumentality in aid of the discharge of its duty is clearly and distinctly affirmed; and it is, therefore, most respectfully and most confidently submitted that Congress has the power to employ in aid of the exercise of this power said Court of Appeals, as it has expressly done by the act creating it, for the purpose of determining a controversy of this kind, and said court having already on appeal from the Commissioner in this case, determined which of the contesting parties is entitled to this patent, and said court being the last of the instrumentalities provided by statute, the Commissioner is without any power to do anything other than to conform to the decree of said court.

Therefore, the application of appellant to a justice of the supreme court of the District of Columbia to compel the

Commissioner, by writ of mandamus, to award the patent otherwise than as directed by said court had no foundation upon which to rest, and the refusal of the justice to whom that application was made to grant it must be affirmed.

III.

The Act Conferring Jurisdiction upon this Court to Determine Cases of Interference is Clearly within the Constitutional Power of Congress; but, Even if this were Doubtful, that Doubt Must be Resolved in Favor of the Power.

Judge Cooley, in his work on Constitutional Limitations, says that "the constitutionality of a law is to be presumed," and that it should never be declared void unless its nullity and invalidity are beyond a reasonable doubt—that "a reasonable doubt must be solved in favor of the legislative action, and the act be sustained" (side page 182 and note).

This principle is thus stated in 3 American and English Encyclopædia of Law, at pages 673 and 674:

"It is the right, and consequently the duty, of the judicial tribunals to determine whether a legislative enactment drawn in question in a suit pending before them is repugnant to the Constitution of the United States or of the State, and, if so found, to declare it inoperative and void. *But every presumption and intendment is in favor of the constitutionality of an act of the legislature, and the courts will not be justified in pronouncing it invalid unless satisfied beyond a reasonable doubt of its repugnance to the Constitution; and nothing but a clear violation of the Constitution—a clear usurpation of the power prohibited—will warrant the judiciary in declaring an act of the legislative department unconstitutional and void.*"

See, also, cases cited in notes.

In the case of *Cooper vs. Telfair* (4 Dall., 18), Justice Washington, in delivering the opinion of the court, says:

"The presumption, indeed, must always be in favor of the validity of laws if the contrary is not clearly demonstrated."

In *Ogden vs. Saunders* (12 Wheat., 270), the court says:

"It is but a decent respect due to the wisdom, the integrity, and the patriotism of the legislative body by which any law is passed to presume in favor of its validity, until its violation of the Constitution is proved *beyond all reasonable doubt.*"

Same thing, 1 Abb. U. S., 52.
See, also, Sinking Fund cases, 99 U. S., 700, 718, and Powell *vs.* Pennsylvania, 127 U. S., 678, 684.

In *Pollock vs. Farmers' Loan & Trust Co.*, income-tax case (157 U. S., 554), opinion by Fuller, C. J., the court says:

"Necessarily the power to declare a law unconstitutional is always exercised with reluctance; but the duty to do so, in a proper case, cannot be declined, and must be discharged in accordance with the deliberate judgment of the tribunal in which the validity of the enactment is directly drawn in question."

IV.

A Complete Remedy is Afforded by Statute without Resort to Writ of Mandamus.

By section 4915 of the Revised Statutes it is provided that any party who may be aggrieved by the decision of the supreme court of the District of Columbia, or the Commissioner of Patents, may have his rights adjudicated in a proceeding in equity in the proper court; and thus it appears that a full and complete remedy is afforded without resort to the extraordinary remedy of mandamus.

The jurisdiction of the supreme court of the District of Columbia was transferred to the Court of Appeals of the District of Columbia (Act of Congress, February 9, 1893, 27 Stats., 434).

Referring to this section of the Revised Statutes, the Supreme Court of the United States, in said case of *Butterworth vs. Hoe* (*supra*), says as follows:

"It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced, and upon the whole merits. Such has been the uniform and correct practice in the circuit courts (*Whipple vs. Miner*, 15 Fed. Rep., 117; *Ex parte Squire*, 3 Ban. & A., 133; *Butler vs. Shaw*, 21 Fed. Rep., 321). It is provided that the court having cognizance thereof, on notice to adverse parties, and after due proceedings had, may adjudge that such applicant is entitled according to law to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of such adjudication, and otherwise complying with the requirements of the law. And in all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner," etc.

Thus it appears that Congress has not only called to its aid the instrumentalities above alluded to, but has expressly conferred upon parties who may consider themselves aggrieved by such decisions the right to go into a court of equity, and there have the whole matter reviewed; and, such being the state of the legislation, it is respectfully submitted that the extraordinary writ of mandamus to compel the Commissioner to disregard the decision of this court and

issue a patent in conformity with his own decision, cannot be resorted to except in total disregard of all the principles underlying the right to such a remedy.

The object of a mandamus is not to supersede a legal remedy, but rather to supply the want of it. Two prerequisites must exist to warrant a court in granting this extraordinary remedy. *First*, it must appear that the relator has a clear legal right to the performance of a particular act or duty at the hands of the respondent; and, *second*, that the law affords no other adequate or specific remedy to secure the enforcement of the right and the performance of the duty which it is sought to coerce In this sense the remedy may be regarded as of *dernier resort*, to be used when the law affords no other adequate means of relief (High's Extraordinary Legal Remedies, p. 13, sec. 10, and cases cited).

In the case of *Kendall vs. Stokes* (3 How., 99), the court, Taney, C. J., speaking of the writ of mandamus, says:

"That a party was entitled to it when there was no other adequate remedy. * * * *Whenever, therefore, a mandamus is applied for, it is upon the ground that he cannot obtain redress in any other form of proceeding.* And to allow him to bring another action for the very same cause after he has obtained the benefit of the mandamus would not only be harassing the defendant with two suits for the same thing, but would be inconsistent with the grounds upon which he asks for the mandamus, and inconsistent also with the decision of the court which awarded it."

In the case of *Knox County, &c., vs. Aspinwall* (24 How., 376–383), the court, Grier, J., states the same thing, as follows:

"It must be admitted, that, according to the well-established principles and usage of the common law, the writ of mandamus is a remedy to compel any person, corporation, public functionary or tribunal to perform some duty required by law, where the party seeking relief has no other legal remedy, and the duty sought to be enforced is clear and indisputable."

In *Ex parte Virginia Commissioners* (112 U. S., 177), the syllabus correctly states what was decided by the court, as follows:

"A writ of mandamus is not ordinarily granted when the party alleging the grievance has another adequate remedy and that remedy has not been exhausted."

In the case of *Bayard vs. White* (127 U. S., 250) the court, Blatchford, J., lays down the same rule, and says that mandamus will only be granted "where the party seeking re-"lief has no other legal remedy, and the duty sought to be "enforced is clear and indisputable. * * * Both requi-"sites must concur in every case."

The same principle is laid down *In re Pennsylvania Co.* (137 U. S., 453), opinion by Bradley, J.

See, also, same thing held in *Morrison, petitioner* (147 U. S., 26).

By referring to the record herein it will be seen that the relator has actually invoked the remedy provided in section 4915, Revised Statutes United States, by filing in the circuit court of the United States for the district of Indiana a bill in equity. (*See* bill, R., pp. 42–48.)

The decisions of the Supreme Court of the United States are entirely harmonious on this rule of law applicable to the granting or denying of writs of mandamus; and, in view of this settled state of the law, it would seem necessarily to follow that another adequate remedy having been provided by statute (sec. 4915, Rev. Stats., U. S.), and the relator, Bernardin, having elected to invoke and pursue the remedy in equity so afforded him, his present petition for mandamus cannot be entertained.

Respectfully submitted.

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